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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,994	10/26/2000	Dawn C. Maurer	RATLP005C1	7430

26541 7590 03/07/2002

RITTER, LANG & KAPLAN  
12930 SARATOGA AE. SUITE D1  
SARATOGA, CA 95070

EXAMINER

ELISCA, PIERRE E

ART UNIT PAPER NUMBER

2161

DATE MAILED: 03/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.  
09/697,994

Applicant(s)  
Jeffrey A. Straathop et al.

Examiner  
Pierre E. Elisca

Group Art Unit  
2161



☒ Responsive to communication(s) filed on Apr 12, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 30-46 is/are pending in the application.

Of the above, claim(s) 1-29 is/~~are~~ withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 30-46 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2161



Examiner Pierre Eddy Elisca  
United States Department of Commerce  
Patent and Trademark Office  
Washington, D. C. 20231

#### DETAILED ACTION

1. This office action is in response to application serial number 09/697,994 filed on 04/12/2001, which is a continuation of application No. 08/577,278, now U.S. Pat. 6,167,534.
2. Claims 1-29 are canceled and claims 30-46 are presented for examination.

#### *Information Disclosure Statement*

3. The information disclosure statement filed on 5/23/2001 paper #6 has been considered and entered.

#### *Drawings*

4. The drawing is objected to because of the following informalities: Figure 12, second element 620, "Save data coming back from server" should be 622 as specified in the specification, page 23. Appropriate correction is required

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***Specification***

5. Specification is objected to because of the following informalities: Applicant must add at the beginning of the specification that: This application is a continuation of application No. 08,577,278, now U.S. Pat. No. 6,167,534.

Specification is also objected to because of the following informalities:

Applicants have submitted a number of appendix sheets which fail to meet requirements under 37 CFR 1.96. For example, graphics and images are not text and must therefore be included with the figure sheets. Applicants' notations of graphics and images are not permitted in the appendix. Any diagrams containing graphical components must be submitted as figures and normal drawing sheets. Only computer program listings are permitted for appendices. Any changes to the figures such as their numbering, which affects the written specification must also include the necessary amendments among the drawings must be numbered as part of the written specification and meet the requirements of permissible material for that portion of the application. All submitted sheets to be printed as drawings must be submitted to meet all requirements of 37 CFR 1.84 (all sections), 1.81, 1.83, and 35 USC 113 and the PTO Draftsman. All claim elements, including structural features and process steps (e.g., algorithm steps in a flowchart) must be shown in the drawings, 37 CFR 1.83 (a). All elements in the figures should be referenced in the written specification, and vice-versa.

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***Double Patenting***

6. Claims 30-39, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 respectively of U.S. patent No. 6,167,534. Although the conflicting claims are not identical, they are not patentable distinct from each other because both define inventions that are obvious variations of each other achieving the same end result. Accordingly, it would have been obvious to those in possession of the invention defined by claims 30-39 to observe that the limitations describe in claims 30-39 are already included in claims 1-10 of the U.S. Patent No. 6,167,534. One of ordinary skill in the art would have realized that emulating a user and generating the script based on emulating the user function as as the step of "... application calls generation by the software application in response to user interactions" as recited in independent claim 1 of the Patent No. 6,167,534. The difference between the instant application is merely an artful labeling language that does not attribute any patentable differences. Therefore, as such it is an obvious variation of the invention that perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963).

Claims 40-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 respectively of U.S. patent No. 6,167,534. Although the conflicting claims are not identical, they are not patentable distinct from each other because both define inventions that are obvious variations of each other achieving the same end result.

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Accordingly, it would have been obvious to those in possession of the invention defined by claims 40-46 to observe that the limitations describe in claims 40-46 are already included in claim 11 of the U.S. Patent No. 6,167,534. One of ordinary skill in the art would have realized that emulating a user and generating the script based on emulating the user function as as the step of "... application calls generation by the software application in response to user interactions" as recited in independent claim 1 of the Patent No. 6,167,534. The difference between the instant application is merely an artful labeling language that does not attribute any patentable differences. Therefore, as such it is an obvious variation of the invention that perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963).

***Conclusion***

7. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Monday, Tuesday and Wednesday from 5:30AM. to 6:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9769.

**Any response to this action should be mailed to:**

Commissioner of patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**Application/Control Number: 09/697,994**

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(703) 308-9051, (for formal communications intended for entry )

**OR:**

(703) 305-3718 ( for informal or draft communications, please label

“PROPOSED” or” DRAFT”)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA.,  
Sixth floor (receptionist ).



Pierre Eddy Elisca

Patent Examiner

March 04, 2002